Request for extension of time under 37 C.F.R. §1.136

Assignee herewith petitions the Director of the United States Patent and Trademark Office to extend the time for response to the Office Action dated May 8, 2002 for 1 month(s) from August 8, 2002 to September 8, 2002.

Please charge Deposit Account #02-2666 in the amount of:

___X_ ($110.00 for a one month extension)
_____ ($400.00 for a two month extension)
_____ ($920.00 for a three month extension)
_____ ($1,440.00 for a four month extension)

to cover the cost of the extension.

Remarks

Reexamination and reconsideration of this application, is requested. Claims 1-22 remain in the application and claim 13 has been amended. No new claims have been added or canceled.

Applicant believes there is no additional charge for this response because no new claims have been added.

Support for Amendments

As indicated above, claim 13 has been amended. Support for the amendment may be found at least in Applicant's specification at page 11, lines 5-17.

Applicant respectfully submits that no new matter has been added.

Response to the 35 U.S.C. §102(e) Rejection

The Office Action rejects claims 1-22 under 35 U.S.C. §102(e) as being anticipated by Tischler et al. (US 2001/0049771 A1). Applicant respectfully traverses this rejection in view of the remarks that follow.

As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Office Action must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, the Office Action has not succeeded in making a prima facie case.

During the interview on August 14, 2002, the Examiner clarified the basis of the rejection by stating that Tischler et al. teaches prioritizing a locked way higher than a recently used way based on the first half of the first sentence of paragraph 62, which states, "Locking down a Way means that the Way is never replaced regardless of the "least recently used" us indicator (i.e. LRU) of that Way." Further, the Examiner stated that the subsequent portion of paragraph 62 related to "valid" and "not dirty" was not relevant to the rejection.

However, for at least the reasons outlined below, Applicant respectfully submits that Tischler et al. cannot anticipate Applicant's claims because, at a minimum, Tischler et al. does not teach or suggest locking a way, and then prioritizing the locked way higher than a recently used way.

Tischler et al. contains no express teaching or suggestion of prioritizing

To begin, the portion of Tischler et al. relied upon by the Examiner contains no express teaching of prioritizing locked ways higher than other ways. Rather, the relied upon portion of Tischler et al. only discusses locking a way of a cache thereby preventing that particular way from being victimized in the future.

The Examiner stated during the interview that locking a way was the same as prioritizing the way. However, Applicant respectfully submits this is inaccurate for at least the following reason. Although the scope of Applicant's invention is

not limited in this respect, Applicant's specification states "In this particular embodiment, the highest priority is given to a way (e.g., one of ways 31-34) that is locked, although the scope of the present invention is not limited in this respect. For example, a way that is locked is given higher priority over the most recently accessed way. Thus, LRU update controller 90 may indicate that a locked way is the highest priority (e.g., most recently used) even though it has not been accessed by processor 110 during one of the recent requests for information." (page 11, line 21, to page 12, line 2). As is clear from this example, prioritization relates to the ordering of the ways and is not specifically limited to just locking a way to prevent it from being victimized as suggested by the Examiner during the interview.

Tischler et al. teach that you do not prioritize locked ways.

Tischler et al. teach in paragraph 62 that a locked way **is not prioritized higher than the other ways of the cache.** Tischler et al. teach that a "least recently used" LRU indicator is used to determine which of the ways in the cache is the least recently used. Tischler et al. further teach that the LRU algorithm may even identify that a locked way is the least recently used way – "Locking down a Way means that the Way is never replaced **regardless** of the "least recently used" use indicator" (emphasis added.)

However, Tischler et al. teach that because the way is locked, it is not victimized even though the locked way was identified by the LRU algorithm as being the least recently used way. **In other words, Tischler et al. teaches that a locked way is not prioritized higher than the other ways when the LRU indicator is**

used, instead a locked way is considered by the LRU algorithm. Thus, Tischler et al. teach away from Applicant's claimed invention.

The Examiner may not rely on inherency

Lastly, during the interview the Examiner stated that Tischler et al. "inherently" teach prioritizing a locked way higher than a recently used way and that such a teaching was "embedded" in Tischler et al.

However, the Court of Appeals for the Federal Circuit has stated repeatedly, that Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *948 F.2d at 1269, 20 USPQ2d at 1749* (quoting I *n re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).*"

Applicant respectfully submits that the Office Action has not established a prima facie showing to establish that prioritizing a locked way higher than a recently used way is inherent or embedded in Tischler et al.

Thus, Applicant respectfully submits that Tischler et al. cannot anticipate Applicant's claims 1-22 for at least these reasons.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed May 8, 2002, and it is submitted that claims 1-22 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of amended claims 13-16 is earnestly solicited.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

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